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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/005,415

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Mitchell D. Eggers

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EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,415

Applicant(s)

EGGERS, MITCHELL D.

Examiner

Robert B. Harrell

Art Unit

2142

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

Art Unit: 2142

1. Claims 1-60 remain for examination.

2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

3. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

4. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

5. **Claims 1-53 and new claims 54-60 of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 63-72, 76-80, 82, 83, 86-93, 102-109, and 113-115 of United States Patent Application 10/005,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/005,529 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/005,529.

6. **Claims 1-53 and new claims 54-60 of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-40 and 58-69 of United States Patent Application 10/007,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/007,355 application claims encompasses the claims of this United States Application by the removal of a

Art Unit: 2142

client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/007,355.

7. Claims 1-53 and new claims 54-60 of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-64 and 58-86-114 of United States Patent Application 10/150,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/150,771 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/150,771.

8. The rejection, and grounds for rejection under the judicially created doctrine of obviousness-type double patenting as presented in examiner's prior Office Action, mailed 15 February 2006, are hereby maintained and incorporated in this Office Action by reference as indicated above. The only remarks, by the applicant in his 15 June 2006, on the above cited rejection was that the applicants (it is seen that there is only one applicant of record) note that claims 1-53 are all rejected under judicially created doctrine of obviousness-type double patenting. The applicant[s] will file Terminal Disclaimers as appropriate upon indication that the claims include allowable matter. ***However***, until such Terminal Disclaimers are filed, these rejections and grounds for rejections will continue and be incorporated by reference in this and any other subsequent Office Action either directly by those subsequent Office Action or by reference into those subsequent Office Action by this Office Action.

9. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the each reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the

Art Unit: 2142

international application designated the United States and was published under Article 21(2) of such treaty in the English language;

11. **Claims 1-60 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1).

12. The rejection, and grounds for rejection, under 35 U.S.C. 102(e) as presented in examiner's prior Office Action mailed 13 June 2005 and 15 February 2006, are hereby maintained and incorporated in this Office Action by reference.

13. The applicant argued in his 15 June response by stating in substance that:

a) Milosavljevic does not teach nor suggest a plurality of discrete sample nodes but instead teaches an array of probes and a sample that is applied to the array of probes by addressing the word "discrete" on page 11 of the applicant's 15 June 2006 response. **However**, as stated by Milosavljevic "the probes in each test site differ from the probes in other test sites in a known manner". Since they "differ" they are discrete. Also, the sample must be discrete in Milosavljevic to prevent for cross contamination of the samples as better covered in figure 5 and figure 5A of Milosavljevic and as covered in paragraph [0094] as an example and starting with paragraph [0118] in that there were plural samples clearly not commingled in a single container permitting for cross contamination but rather each sample individually packaged and place into a container of samples for shipping and retrieval from the containers at the test site;

b) Milosavljevic does not teach nor suggest a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for irremovably attaching a corresponding discrete sample node nor radial elements for maintaining a predetermined spatial relationship between a plurality of sample structures. **However**, Milosavljevic taught a sample archive (e.g., see Title) comprising a plurality of sample carriers (e.g., see figure 5 and 5A); each of said plurality of sample carriers configured to support a plurality of discrete sample nodes (e.g., see [0094] and/or [0098]) to [0103]. Also taught was a processor responsive to said means for receiving and operative to retrieve selected ones of said data records from said database (e.g., see [0098] to [0103] note ""When a particular sample is requested, automated equipment such as robotics may be used to select and obtain the corresponding DNA sample and provide the sample to the microarray for interrogation." in [0100]) along with a sample retrieval apparatus responsive to said processor and operative to retrieve said selected ones of said plurality of discrete sample nodes [0098] to [0103]. It is noted that the cards were also samples and that while figure 5 showed only one array, the addition of more was an anticipated expansion and thus Milosavljevic taught a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for irremovably attaching a corresponding discrete sample node per the Abstract, figure 5 (radial), figure 5A, figure 18 (i.e., "sample storage 880" and "05),0034], [0052] "sample archives", [0065] to [0069], [0094]-et seq., and [0119]-et seq., [0124], [0129 "assay"], directed to the client provided biological samples and the microarray. In order to conduct tests on the samples, and for the samples to be shipped to the provider, they must be housed in discrete housings which were removable from their carriers.

Art Unit: 2142

14. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action::

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-60 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1) in view of Brignac, JR et al. (United States Patent Application Publication US 2004/0014228A1).

16. The rejection, and grounds for rejection, under 35 U.S.C. 103(a) as presented in examiner's prior Office Action mailed 13 June 2005 and 15 February 2006, are hereby maintained and incorporated in this Office Action by reference.

17. The applicant argued in his 15 June 2006 response by stating in substance that Brignac does not teach nor suggest a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for irremovably attaching a corresponding discrete sample node nor radial elements for maintaining a predetermined spatial relationship between a plurality of sample structures. **However**, such was addressed above in that the samples were anticipated to be shipped in carriers separated from each other and removable from the carriers for testing. Also, such was covered by Brignac's Title and figure 1, figure 2, figure 3, figure 4, and related text, in that the samples were robotically removed for computerized testing, as called for by Milosavljevic. Thus, it would have been obvious for those skilled in the data processing art to conduct computerized genetic biological analyses of samples requested via a network by a remote client where the samples were robotically obtained from a repository holding a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for irremovably attaching a corresponding discrete sample node and radial elements for maintaining a predetermined spatial relationship between a plurality of sample structures of the type covered in [0021], as an example, of Brignac.

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2142

19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'Robert B. Harrell', with a long horizontal flourish extending to the right.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142